

## REMARKS

In the Office Action, the Examiner rejected claims 10, 14, and 18 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner also provisionally rejected claims 10-21 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of United States Patent Application No. 09/792,485. The Examiner also rejected claims 10-21 under §103(a) as being unpatentable over the United States Patent No. 6,006,127 issued to Van Der Brug, et al. ("Van Der Brug") in view of the United States Patent No. 5,299,288 issued to Glassman, et al. ("Glassman") and the United States Patent No. 6,064,904 issued to Yanof, et al. ("Yanof") further in view of the United States Patent No. 6,920,347 issued to Simon, et al. ("Simon").

In this Amendment, Applicant has amended claims 10 and 13-19. The Amendments are made for reasons of clarity rather than patentability and Applicant does not surrender any equivalents of the amended claims. Applicant has not added or canceled any claims. Accordingly, claims 10-21 will be pending after entry of this Amendment.

### **I. Rejection of Claims 10, 14, and 18 Under 35 U.S.C. §112, First Paragraph**

In the Office Action, the Examiner rejected claims 10, 14, and 18 under §112, first paragraph, as failing to comply with the written description requirement. The Examiner stated that claims 10, 14, and 18 contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner objects to the use in the claim of "a second image capture instrument."

Applicant respectfully submits that the claims only contain subject matter that was described in the specification as originally filed. In the Office Action, the Examiner indicated that the "second image capture instrument" is not supported in the specification. This language,

read in light of the “first tracked instrument” of previously presented claims 10, 14, and 18, does not indicate that a method involving two image capture instruments is claimed, but rather that the method includes using an image capture instrument as part of the method for maintaining a trajectory of a tracked instrument. The specification clearly describes an image capture instrument. As one example, in the “Summary of the Invention” section, at paragraph 12, lines 8-11: “An imaging device in communication with the tracking controller generates an image of the target site and intervening tissue as seen from a selected point outside the body.”

To obviate the issue, Applicant has amended the claims to refer to “a tracked first instrument” and “an image capture second instrument.” These amendments are made for reasons of clarity rather than patentability. Applicant does not surrender any equivalents of the amended claims. Therefore, Applicant respectfully submits that claims 10, 14, and 18 comply with the written description requirement of §112, first paragraph. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the §112 rejection.

## **II. Nonstatutory Obviousness-type Double Patenting**

In the Office Action, the Examiner provisionally rejected claims 10-21 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent Application No. 09/792,485. Applicant respectfully notes that Application No. 09/792,485 is abandoned, and therefore is not copending. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the provisional nonstatutory obviousness-type double patenting rejection of claims 10-21.

## **III. Rejection of Claims 10-21 Under 35 U.S.C. §103(a)**

In the Office Action, the Examiner rejected claims 10-21 under §103(a) as being unpatentable over Van Der Brug in view of Glassman and Yanof further in view of Simon. Applicant respectfully submits that the filing date of Simon is 6/21/2002. Simon is a

continuation of U.S. Patent Application No. 09/545,092, which has an effective filing date of 4/7/2000. The present application is a continuation application and claims benefit to U.S. Patent Application No. 09/792,485, filed 2/23/2001, which claims the priority of U.S. Provisional Application No. 60/185,036, filed 2/25/2000. Provisional Application 60/185,036 contains similar disclosure to the present application and parent Application 09/792,485, and fully supports all limitations of all claims 10-21. Note the similarity between Figures 1-7B of the present application and Figures 1-7B of Provisional Application 60/185,036, as well as that the description in the present application mirrors that of Provisional Application 60/185,036. Therefore, the present application has an effective filing date of 2/25/2000. Accordingly, Simon is not available as prior art for the rejection under §103(a). Furthermore, even if Simon was available as prior art, the piecemeal, hindsight combination of Van Der Brug, Glassman, Yanof, and Simon does not disclose, teach, or even suggest the methods, computer readable mediums, and devices of claims 10-21. In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 10-21.

## CONCLUSION

Applicant respectfully submits that all of the pending claims, namely claims 10-21, are in condition for allowance. Allowance is earnestly solicited at the earliest possible date.

Applicant believes that no fees are due for this response. However, in the unlikely event that any required fee is not paid, the Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. §§ 1.16 and 1.17 that may be required by this response, or to credit any overpayment to **Deposit Account No. 50-3804** referencing docket no. **STAN.P0010CON**.

Respectfully submitted,

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